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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,995	12/27/2000	Clare E. Woodman	F-180	6429

919 7590 10/05/2004

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,995

Applicant(s)

WOODMAN, CLARE E.

Examiner

John R Paradiso

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 5, 7 and 8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 5, 7, and 8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 3721

DETAILED ACTION

Request for Continued Examination

1. The request filed on 10/1/04 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/748,995 is acceptable and a CPA has been established. An action on the CPA is attached.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 line 4 recites "the mailer's legacy computer" but does not specifically define the limits or bounds of that recitation.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 3721

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over ANDERSON, JR. ET AL.

ANDERSON, JR. ET AL discloses a method of processing mail pieces in which a printstream is generated in a computer (40) and transmitted to printers (50) for printing documents, which are delivered to inserter systems (20). A reprint database is generated as needed by the database server (10) and a supervisor client monitors each job, tracking the printstream, the mail pieces, and generating reprints or reports as needed. (See ANDERSON, JR. ET AL column 3 line 43 to column 4 line 30 and figure 1.)

Examiner notes that the claim steps of “interpolating the printstream” to generate a reprint database and a job tracking database is inherent in the method disclosed by ANDERSON, JR. ET AL, since the generation of a database in one computer, transmittal of that database to a second (or successive) computer, and re-creation of that database in a form that can be printed inherently implies interpolation of the database from an electronic format to a printable format.

ANDERSON, JR. ET AL does not specifically disclose the additional step of transmitting the printstream to a workstation computer . . .” and there interpolating the data for a reprint database and a tracking database.

Applicant is given Official Notice that the transmitting of data from one computer to another in order to perform different functions at a remote computer or workstation is well known in the art and in everyday life, where anyone with a computer can upload or download databases and exchange/interpolate data on or from a remote computer via the Internet) in order to reduce the computing load on any one workstation, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of

Art Unit: 3721

ANDERSON, JR. ET AL to send the printstream to computer workstations to generate the reprint and tracking database in order to reduce the workload on the remote computer, saving computer run time.

Examiner notes that while the preamble to claim 5 recites "each of the plurality of inserter systems having different proprietary control systems," said control systems are not positively recited or provided for in the claims.

Response to Arguments

6. Applicant's arguments filed 6/11/2004 have been fully considered but they are not persuasive.

7. Applicant states on page 5 of his Response that "Anderson does not include steps for providing an 'appropriate format for each of the different proprietary control systems'."

However, as explained above:

Examiner notes that the claim steps of "interpolating the printstream" to generate a reprint database and a job tracking database is inherent in the method disclosed by ANDERSON, JR. ET AL, since the generation of a database in one computer, transmittal of that database to a second (or successive) computer, and re-creation of that database in a form that can be printed inherently implies interpolation of the database from an electronic format to a printable format.

Art Unit: 3721

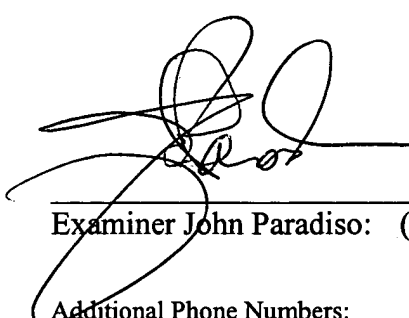
This "transmittal of that database to a second (or successive computer)" is an example of providing an appropriate format for each control system. If the data were transmitted in any other than the appropriate format for each control system, the transfer would not work.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (703) 308-2825

October 1, 2004

Additional Phone Numbers:

Supervisor Rinaldi Rada: (703) 308-2187
TC 3700 Receptionist: (703) 308-1148
Fax (directly to Examiner) (703) 746-3253
Fax (Official): (703) 872-9306